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PATENT

Serial No: 10/034,119

Attorney Docket: 2671-4



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Carter F. Lloyd

Serial No.: 10/034,119

Filed: January 3, 2002

For: SHINGLE REMOVER

Examiner: James G. Smith

Art Unit: 3723

REPLY BRIEF

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Commissioner for Patents

P.O. Box 1450

Alexandria, Va. 22313-1450

ATTENTION: Board of Patent Appeals and Interferences

Sir:

Appellant submit this Reply Brief in the above-referenced application. The Examiner's Answer was mailed on June 4, 2004.

ISSUES

In the Appeal Brief, Appellant asserts that one of skill in the art would not have combined Small and Verna as suggested by the Examiner. Specifically, Appellant points out that the extraction device of Small is designed to remove unheaded pins with a jaw 15 having a single gripping tooth 41, and a jaw 17 having a single gripping tooth 61, each having a biting edge. The teeth 41 and 61 are used to grip the object to be pulled. One of the jaws may be of a conventional design.

Appellant asserts in the Appeal Brief that Small is concerned with the particular problem of removing small, hard to grip objects such as pins. Appellant further asserts that one of skill in the art would not have modified Small to include the jaws of Verna, since doing so would

deprive Small of its primary aim of effectively gripping small pin-like objects. Appellant further asserts that nothing in either reference suggests such a motivation.

In response, the Examiner asserts that the shape of the jaws of Small is similar to that of the workpiece in that it is a curve that provides a more comprehensive gripping area around the workpiece. The Examiner further asserts that the flat jaw gripping surfaces of Verna match the substantially flat piece of metal that Verna grips. As supposed motivation for replacing the pins of Small with a flat gripping surface as disclosed in Verna, the Examiner asserts that “[t]hus when the workpiece is that of a substantially flat surface, one skilled in the art would be lead by Verna to construct the gripping surfaces of each jaw to match that of the workpiece.” *See Examiner's Answer*, p. 4.

The Examiner's combination can only be made with impermissible hindsight consideration of Appellants disclosure. The Examiner is ignoring teachings in the references that teach away from the claimed invention, and ignoring that the combination would result in a device that would likely no longer function for it's intended purpose, as further discussed below.

First, the Examiner's assertion that the shape of the jaws of Small is similar to the shape of the workpiece (curved) is incorrect. In fact, Small discloses that tooth 41 should be made such that it will bite into the object to be pulled and provide a firmer grip. The tooth 41 is secured in hole 42, with a biting edge 47 of the tooth 41 protruding just below a cutout in subassembly 40. The cutout may have a curvature 50 that helps insure that the bite of tooth 41 is not too deep to prevent potential breakage of the pin. *See col. 4, lines 30-42*. Thus, the primary gripping of the pin is applied by the tooth 41, and the jaws are not shaped similar to the workpiece as asserted by the Examiner.

Further, the Examiner ignores that the jaws of Verna include arcuately curved rows of teeth which interfit with one another. *See col. 1, lines 31-40 and col. 2, lines 42-55*. If jaws having such arcuately curved rows of teeth as taught by Verna were included in the device of Small, the resulting modification of Small would no longer be effective for it's intended purpose of gripping a pin, since the pins are generally straight and the curved teeth would prevent effective gripping. The Examiner thus ignores disclosures in the references that teach away from

the combination and ignores that the resulting combination would no longer function effectively for it's intended purpose. Such a combination can thus only be made with impermissible hindsight consideration of Appellant disclosure.

The Examiner further suggests that the flat jaw 312 of Wang could be used to modify the device of Small. *See* Examiner's Answer, page 3. However, the Examiner again ignores that Small teaches the use of the tooth with a cutout in the jam for effective gripping of the pin. The modification suggested by the Examiner would prevent the device of Small for effectively functioning for it's intended purpose of gripping the pin. Such a modification again ignores Small's teaching of using the tooth and cutout to grip the pin. Thus, one of skill in the art would not make the suggested modification.


For all of the above reasons, it is submitted that the combination asserted by the Examiner can only be made with improper hindsight consideration of Appellant's disclosure. It is requested that the rejections be overturned.

CONCLUSION

Appellant respectfully requests reversal of the rejections of claims 49-60. These claims are allowable over the cited art.

Respectfully submitted,

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